



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,624	03/07/2001	Klaus Gassenmeier	GRISA/710	7473
26875	7590	04/08/2004	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			WONG, LESLIE A	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/800,624
Filing Date: March 07, 2001
Appellant(s): GASSENMEIER ET AL.

Paper No. 0404

MAILED
APR 08 2004
GROUP 1700

Beverly Lyman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 15, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the stand or fall together.

Art Unit: 1761

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

GB 1,409,209 CHIBA et al 10-1975

Ashurst, Ed., Food Flavorings, Second Edition, Blackie Academic & Professional, New York, 1995, pages 155-157.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chiba et al (GB 1409209) in view of Ashurst.

Chiba et al disclose the claimed compounds (see entire document, especially page 1, lines 47-74).

The claims differ as to the specific use of the claimed compounds as flavoring agents.

Ashurst discloses the well-known use of mercaptans as flavoring agents where the mercaptans have low threshold values (see pages 155-157).

Art Unit: 1761

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to use the compounds of Chiba et al as flavorants because the use of mercaptans as flavoring agents is conventional in the art as taught by Ashurst.

In the absence of a showing to the contrary, the claimed amounts are seen to be no more than a matter of choice and well within the skill of the art. At most, the claimed amounts are seen to be optimization, see *In re Boesch* 205 USPQ 215.

(11) Response to Argument

Appellant argues that there is no motivation to combine Chiba et al with Ashurst because Chiba et al is not directed to flavor or fragrances, and that if the references were combined there is no reasonable expectation of success. Appellant also argues that the prior art does not teach the desired flavor or fragrance (i.e. fruity taste).

Chiba et al disclose the claimed compounds (see entire document, especially page 1, lines 47-74).

Ashurst discloses the well known use of mercaptans as flavoring agents where the mercaptans have low threshold values (see pages 155-157).

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 1761

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references are directed to mercaptans where it is well known to one of skill in the art that mercaptans are used as flavorants/fragrances.

It is well known that sulfur-containing components are an important class of flavorings (Ashurst, page 156, lines 6-8). US. Patent Nos. 4,631,194 and 5,047,256 are considered merely to show the additional conventional use of sulfur-containing food compounds, but are not relied upon.

Appellant's claims are not limited to a desired flavor or fragrance. Appellant does not specifically limit to a fruity taste nor does Appellant provide results for a fruity taste that encompass an R1 of "a branched or unbranched alkyl, alkenyl or alkadiendyl group containing 1 to 8 carbons" and an R2 of "a methyl or ethyl group"

It is not seen where Appellant has established anything other than expected results. It is clear from the discussion by Appellant that no issue is taken with the fact that Chiba et al teaches the specifically claimed compound. The observation of an inherent characteristic cannot be basis for patentability, see *In re Best* 195 USPQ 430 and *In re Jones* 1941 CD 686.

The declaration under 37 CFR 1.132 filed August 27, 2003 is insufficient to overcome the rejection of the claims based upon Chiba et al in view of Ashurst for the following reasons.

- 1) The showing does not specifically compare to the art relied upon and is not commensurate in scope with the claims.
- 2) The conclusions appear to be subjective rather than objective.

Art Unit: 1761

3) No data or statistical analysis is provided to support the conclusions.

All of Appellant's arguments have been considered. None of them are seen to overcome the rejection advanced under 35 U.S.C. 103(a).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Leslie Wong
Primary Examiner
Art Unit 1761

LAW
April 2, 2004

Conferees:

Glenn Caldarola

Milton Cano

WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202



MILTON I. CANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700



Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700